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APPLICATION NUMBER 081485,070	FILED DATE 06/17/99	INVENTOR GETREUER	FIRST NAMED APPLICANT	ATTORNEY DOCKETING NO. D-1
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LM02/0426

DIN EXAMINER

ART UNIT 52

PAPER NUMBER

296/99

DATE MAILED:

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS
OFFICE ACTION SUMMARY
☒ Responsive to communication(s) filed on 4/7/99
☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

 A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).
Disposition of Claims
☒ Claim(s) 1, 12-71 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 12-71 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.
Application Papers
☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.
Priority under 35 U.S.C. § 119
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
Attachment(s)
☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 27
☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/485,070	06/07/95	GETREUER	K 37436.D-1

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EXAMINER

DINH, T

ART UNIT PAPER NUMBER

2752

DATE MAILED: 04/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 2752

1) The amendment filed on 04/07/99 is acknowledged. New Claims 48-71 have been currently added.

2) The I.D.S filed 04/07/99 has been considered by Examiner. However, the Japanese/foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the Abstract (English language) and the drawings.

Form PTO-1449 is(are) attached herein.

3) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed TERMINAL DISCLAIMER in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A TERMINAL DISCLAIMER signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2752

4) Claims 1,17-71 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,677,899 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming *common* subject matter, as follows: Determining first and second radial directions, determining circumferential distance, determining an initial circumferential velocity, calculating velocity trajectory and moving carriage assembly from initial position to target position.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5) IMPORTANCE NOTE TO APPLICANT: Since the drawings have been changed and involved so many sheets/figures, applicant is required to submit a complete set of the drawing in next communication. It is also noted that, the indication for changes

Application/Control Number: 08/485,070

Page 4

Art Unit: 2752

in the drawings must also be added to the specification for consisting.

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN DINH whose telephone number is (703)308-4859. The Examiner can normally be reached on Monday - Friday from 8:00AM to 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703)305-9731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



TAN DINH
PRIMARY EXAMINER

April 22, 1999